

Amendments to the Drawings:

The attached drawing sheet includes changes to Fig. 1. This replacement sheet, which includes Fig. 1, replaces the original sheet including Fig. 1.

Attachment: replacement sheet

REMARKS

To accompany the present Amendments, Applicants respectfully offer the following response to the March 17, 2008 Office Action (“Office Action”).

The Specification

In the specification, Paragraphs [0047], [0052], [0082], [0093], [0100], [0103], [0107], [0108], [0110], [0117], and [0119]-[0121] are amended. In particular, Paragraphs [0047], [0052], [0082], [0100], [0107], [0108], [0110], and [0119]-[0121] are amended to correct typographical and/or grammatical errors. Paragraphs [0093], [0103], and [0117] are amended for purposes of promoting clarity and aligning the textual disclosure in the specification with the graphical disclosure provided in originally filed drawing Figs. 15, 16, and 17, respectively.

The Drawings

Drawing Fig. 1 is amended to provide reference number “100” that was previously inadvertently omitted and corresponds to the drawing element “system 100” described in Paragraph [0026] of the specification as originally filed. A replacement drawing sheet for amended Fig. 1 is attached hereto. Applicant asserts that no new matter has been introduced by this amendment.

The Claims

1. Status of the Claims

Claims 1-95 are pending in the present application, of which claims 1, 27, 41, 47, 70, and 91 are in independent form. Each of original filed claims 1-95 were rejected in the Office Action. Specifically, claims 27-40 and 70-90 were rejected under 35 USC 101, claims 1-4, 6-28, 30-52, and 54-93 were rejected under 35 USC 102, and claims 5, 29, 53, 94, and 95 were rejected under 35 USC 103.

2. Applicants’ Response Traversing the Claim Rejections Asserted in the Office Action as being Legally Insufficient and/or No-Longer Applicable for the Claimed Subject Matter

For the reasons discussed in detail below, and in consideration of the present amendments, Applicants respectfully assert that the claims pending in the present application,

either as originally filed or as currently amended, present statutory subject matter and novel and non-obvious improvements over the prior art references of record. Accordingly, Applicants' believe the claims are in a condition for allowance and respectfully request the same.

A. The Rejection of Claims 27-40 and 70-90 under 35 U.S.C. 101 is Legally Insufficient and also Rendered Mute in Light of the Present Amendments

Originally filed claims 27-40 and 70-90 were rejected in the Office Action under 35 U.S.C. 101 as being "directed to non-statutory subject matter." (Office Action, Pg. 2, Paragraph 1). Applicants respectfully traverse the rejection as being legally insufficient based on a failure to articulate precisely what evidence or reasoning led to a factual finding supporting the rejection. The cited statutory ground for rejection is not supported by the evidence on record, and, even if it were, the rejection is mute in light of the present claim amendments.

1) Applicable Standard Defining Statutory Computer-Readable Subject Matter

Claimed subject matter is statutory if it encompasses descriptive material that is functional in nature. "When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized." (MPEP 2106.01). Furthermore, "a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permits the computer program's functionality to be realized, and is thus statutory." (MPEP 2106.01 I. (citing *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d at 1031, 1035 (Fed. Cir. 1994)).

2) Claim Rejections under 35 USC 101 are Unsupported by Clear Factual Findings and Therefore Legally Insufficient

While the Office Action appears to intimate that at least a portion of the relevant claims may have been determined to represent "nonfunctional descriptive material" (*see*, Office Action, Pg. 2, Paragraph 3), Applicants are unable to determine or identify within the

Office Action the specific evidence or reasoning applied to reject the claims. The precise basis supporting the rejection is never explicitly articulated.

Paragraph 1 of the Office Action merely offers a conclusion that the relevant claims were “rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.” (Office Action, Pg.2, Paragraph 1). Paragraph 3 excerpts text from Section 2106.01 of the MPEP, but does not apply the excerpted language to the individual elements of Applicants’ claims. In Paragraph 2, the Office Action offers partially quoted sections from Applicants’ specification, as originally filed, relevant to the phrases “computer readable media,” “computer storage media,” and “communications media” in Applicants’ disclosure, followed by a statement suggesting alternative language for the relevant rejected claims. (Office Action, Pg. 2, Paragraph 2).

Applicants are unclear whether the segments of Applicants’ specification partially quoted in Paragraph 2 of the Office Action are intended to represent evidence for a factual finding in support of a legal conclusion of “non-statutory subject matter,” or whether the quoted sections are meant to indicate disclosure within the Applicants’ specification that supports the suggested alternative claim language, which, in turn, is suggested in the Office Action for purposes of illustrating *statutory subject matter*. Given that the factual findings or reasoning supporting the rejection are either unclear, unsupported by evidence, or altogether absent from the record, to the extent that the quoted excerpts are intended either to support or serve as a basis for the rejection, Applicants traverse the present rejection as being legally insufficient on the record.

3) In Addition to being Legally Insufficient, the Rejection under 35 USC 101 is Mute in Light of the Present Amendments

Although Applicants believe that the Office Action does not provide the substantial evidence legally required for a factual findings to support of the rejection of claims 27-40 and 70-90 under 35 USC 101, in order to provide as thorough of a response as possible, Applicants proceed herein operating under the assumption that the claim language suggested in Paragraph 2 of the Office Action is provided to exemplify subject matter that would be adjudged statutory, and that the excerpts from Applicants’ specification that are quoted in

Paragraph 2 of the Office Action are meant to indicate language supporting an amendment as suggested.

As presently amended, independent claims 27 and 70 recite “A computer-readable medium having computer-executable instructions that, upon execution, facilitate a computing device in performing operations comprising:....” Similarly, dependent claims 28-40 and 71-90 are amended to recite “The computer-readable medium of claim....” Language supporting the claim amendments can be found, without limitation, in Paragraphs [0107]-[0110] and [0119]-[0121] of Applicants’ specification. Paragraphs [0107], [0108], [0110], and [0119]-[0121] are also presently amended to employ consistent hyphenation in uses of the phrase “computer-readable.”

Applicants’ claims 27-40 and 70-90 are not directed to a data structure or computer program per se, but rather are directed to a computer-readable medium having computer-executable instructions recited in structural and functional interrelationship with a computing device. The structural and functional interrelationship with the computing device permits the stated functionality of the computer-readable medium’s instructions to be realized. Thus, the amended claims satisfy the standard for statutory subject matter as articulated above.

If Applicants’ assumption as to the intended purpose of Paragraph 2 in the Office Action is incorrect, or if the Examiner does not agree that the claims as presently amended present statutory subject matter, Applicants’ respectfully request that the Examiner respond by providing Applicants with an additional non-final Office Action clarifying the original rejection and making explicit in the record the evidence and/or reasoning relied upon by the Examiner for factual findings supporting the proffered claim rejection.

B. The Rejection of Claims 1-4, 6-28, 30-52, and 54-93 under 35 U.S.C. 102(b) is Improper Because the Rejection is Not Based on Factual Findings Supported by the Evidence on Record

The Office Action rejected claims 1-4, 6-28, 30-52, and 54-93 as being anticipated by U.S. Patent Application No. 2002/0093531 A1 (hereinafter “Barile”). (Office Action Pg.3. Paragraph 4). Applicants respectfully traverse the anticipation rejection proffered in the Office Action as having being based on factual findings that are insufficiently supported by the cited prior art evidence on the record.

Serial No.: 10/677,213
Atty Docket No.: MS1-1676US
RESPONSE TO NON-FINAL OFFICE ACTION DATED : 03/17/2008

1) Applicable Legal Standard for Anticipation

The applicable standard for an anticipation rejection is that “the reference must teach every aspect of the claimed invention either explicitly or impliedly. (MPEP 706.02). Also, as articulated by the Federal Circuit: “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). For the reasons discussed below, the cited prior art evidence does not support the factual findings necessary to establish a valid rejection under 35 U.S.C. 102(b).

2) The Rejections under 35 USC 102(b) are not Based on Factual Findings Having Sufficient Evidentiary Support to Establish Anticipation of Every Element of the Rejected Claims

The Office Action asserted that claims 1-4, 6-28, 30-52, and 54-93 are anticipated by Barile. (Office Action Pg.3, Paragraph 4). In particular, the Office Action cites Barile Paragraphs [0005] and [0026] to support the rejection of Applicants’ independent claims 1, 27, and 41 (*see*, Office Action, Pg.3, Paragraph 5) and Barile Paragraph [0026] to support the rejection of Applicants’ independent claims 47, 70, and 91 (*see*, Office Action, Pg.7, Paragraph 31). Careful study of the evidence provided by the cited passages indicates that Barile does not anticipate every element of the rejected claims, and thus the rejection under 35 U.S.C. 102(b) is improper.

a) Traversal of rejection of claims 41 and 91

First, with respect to the rejection of independent claims 41 and 91, Applicants assert that claims 41 and 91, and their respective dependent claims, are directed to claimed systems, each having specifically recited structural elements; yet the Office Action does not analyze the claims on an element-by-element basis, as required. Rather, it groups the system claims in a single, consolidated rejection that is additionally cited against co-pending method and computer-readable media claims. (Office Action, Paragraphs 5 and 31). “A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.” (MPEP 707.07(d)). Here, the rejections are not applicable to system claims 41 and 91 because the grounds for rejection provided in

Paragraphs 5 and 31 of the Office Action do not specifically address the structural claim elements of Applicants' system claims. The grouped rejection improperly ignores the claimed system elements and rejects the claims based merely on statements regarding functionality allegedly taught by Barile.

Even if the cited disclosures of Barile did teach a system having substantially similar functionality to the systems of Applicants' claims, which Applicants assert it does not, the Office Action does not offer reasoning to support a rejection of Applicants' claimed *structural elements*, in light of such alleged common functionality. "Even if the prior art device performs all the functions recited in the claim, the prior art cannot anticipate the claim if there is any structural difference." (MPEP 2114). Accordingly, the Office Action has not satisfied its initial legal burden for providing clearly articulated evidence and reasoning to support the rejection of claims 41 and 91 over Barile. Furthermore, Applicants note that, as detailed below in Applicants' response to the rejection of claims 1, 27, 47, and 70, even if the Office Action did properly analyze system claims 41 and 91 by citing to a disclosure in Barile of structural equivalents to Applicants' claimed invention, the functionality provided for in the claims is patentably distinct from the functionality disclosed in Barile.

b) Traversal of rejection of claims 1, 27, and 41

With respect to the rejection of independent claim 1, directed to "A method," and independent claim 27, directed, as amended, to "A computer-readable medium having computer-executable instructions that, upon execution, facilitate a computing device in performing operations..." Applicants note that, to support the anticipation rejection of claims 1 and 27 (as well as the rejection of system claim 41), the Office Action merely cites to Paragraphs [0005] and [0026] of Barile, but does not apply the disclosures of the cited paragraphs to the claimed elements on an element-by-element basis, or set forth clear factual findings or a reasoned analysis in such a manner as would allow Applicants a meaningful opportunity to respond. (Office Action, Pg.3, Paragraph 5). Accordingly, Applicants contend that the rejections are legally insufficient and improper on this ground alone, and Applicants traverse the rejections accordingly.

Additionally, careful review of the cited portions of Barile indicates that the cited disclosure provides substantively insufficient evidence for establishing anticipation of the

rejected claims. Applicants note that both claims 1 and 27 are comprised, in part, of a receiving element that provides for “receiving a first signal indicating that the first participant is providing information to the multi-party conference.” The cited portions of Barile, however, disclose no such element. The claimed element provides that the structure performing the method (claim 1) or computing device performing the operations (claim 27) receives a “first signal indicating that the first participant is providing information to the multi-party conference” (emphasis added). The cited disclosure of Barile, on the other hand, teaches “a communications terminal for video conferencing...including a receiver receiving audio and video signals from a plurality of the remote participants, a comparator comparing the received audio signals from the remote participants, a display, and a controller controlling the display to display the video images of the participants based on the comparison of the received audio signals.” (Barile, Paragraph [0005], emphasis added). Barile does not disclose, explicitly or implicitly, receiving a “signal *indicating* that the first participant is providing information....” (Claims 1 & 27, emphasis added).

Rather, Barile receives multiple “signals from a plurality of remote participants” and then uses a “comparator” to “compare the received audio signals” for purposes of controlling a display. (Barile, Paragraph [0005]). The cited disclosure of Barile states that the “comparator may select an audio signal which is strongest to determine which of the participants is active.” (Id.) Further, the cited Barile disclosure provides that “the comparator 40 compares the audio signals received from the various participants...and from that comparison determines which of the participants is the active participant (i.e., which participant is then speaking and/or controlling the exchange of information at that time), and the controller 31 controls the display 30 to display the video images based on that comparison.....” (Barile, Paragraph [0026]). Because of the multiple signals the systems of Barile are configured to receive and process, they specifically are required to make a determination, at the receiving device, as to which participant is actively providing information. Such a specific determination, and use of a comparator in general, would be unnecessary in Barile if the cited reference anticipated Applicants’ claimed element of receiving a signal that indicates that a particular participant is actively providing information. It is specifically because Barile does not receive any such indication from any received signal

that Barile includes a comparator to distinguish among the plurality of signals it receives to “determine which participant is active.” (Barile, paragraph [0005]). If Barile received an indicating signal in the manner Applicants claim, the comparator of Barile would not be required and no such determination would have to be made for purposes of controlling the display at the receiving device.

c) Traversal of rejection of claims 47, 70, and 91

With respect to independent claim 47, directed to “A method,” and independent claim 70, directed, as amended, to “A computer-readable medium having computer-executable instructions that, upon execution, facilitate a computing device in performing operations...,” Applicants note that the Office Action merely cites Paragraph [0026] of Barile but does not apply the cited paragraph to the claimed elements on an element-by-element basis or set forth clear factual findings or a reasoned analysis in such a manner as would allow Applicants a meaningful opportunity to respond. (Office Action, Pg.7, Paragraph 31). Accordingly, Applicants contend that the rejections are legally insufficient and improper for this reason alone, and Applicants traverse the rejections accordingly.

Additionally, careful review of the cited portion of Barile indicates that the evidence it provides is substantively inadequate for establishing anticipation of the rejected claims. Applicants note that both claims 47 and 70 are comprised, in part, of an element for “providing a signal indicating that the detected acoustic signal was generated by the person,” where “the person” refers to a “person speaking,” as determined in a separate “determining” element. Similarly, claim 91 includes as a claim element a “sourcing signaler to selectively provide a signal indicating....the person is speaking.” The Office Action indicates no finding of where the cited disclosure of Barile specifically includes “providing a signal indicating that the detected acoustic signal was generated by the person” (claims 47 and 70) or a “sourcing signaler to selectively provide a signal indicating...the person is speaking... (claim 91). In fact, the cited disclosure of Barile makes no mention of a specific “indicating” signal, as Applicants’ claims recite. On the contrary, Barile teaches using a “comparator” that “compares the audio signals received from the various participants in a video conference and from that comparison determines which of the participants is the active participant (i.e., which participant is then speaking and/or controlling the exchange of information at that time)....”

(Barile, Paragraph [0026]). It is because the cited disclosure of Barile does not provide for the receipt of a “signal indicating that the detected acoustic signal was generated by [a person speaking]” (Claims 47 and 70, emphasis added) that Barile uses a comparator to compare the signals received from the various participants of a video conference in order to determine which participant is active.

Although Applicants assert that the evidence on record does not support factual findings sufficient to establish an anticipation rejection of claims 47, 70, and 91, as originally filed, Applicants’ present amendments to claims 47, 70, and 91 serve to provide additional clarity and further highlight patentable improvement of Applicants’ claimed invention over the cited prior art of record. Most notably, claims 47, and 70 are amended to recite that the “detecting,” “determining,” and “providing” steps or operations are performed via a “first participant equipment” (claim 47) or “first computing device” (claim 70), and the “providing” step or operation includes providing “to a second participant equipment” (claim 47) or “to a second computing device” (claim 70) the “signal indicating...that the detected acoustic signal was generated by [a person speaking].” Similarly, claim 91 is amended to provide that the recited “audio discriminator” and “sourcing signaler” elements of the claimed system are included within “a first participant equipment” and the signal provided by the sourcing signaler of the first participant equipment is for “indicating to a second participant equipment that the person is speaking....” (Claim 91).

The present amendment is adequately supported by Applicants’ original specification and drawings. For example, the complementary relationship of the first and second participant equipment or computing devices of claims 47, 70, and 91 is illustrated in the block diagram of Figure 1. Similarly, Applicants’ specification provides, in relevant part: “The sourcing signaler provides a signal that indicates the identity of a participant providing information to the multi-party conference to be sent to the other participants. The source indicators of the other participant equipment receives the signal and in response, causes a user interface (UI) displayed by the participant equipment to provide an indication that the participant identified by the received signal is providing information.” (Specification, Paragraph [0004]). The Office Action provides no citation to evidence found in Barile that discloses a first participant equipment or computing device providing a signal to a second

participant equipment or computing device for purposes of indicating to the second participant equipment or computing device a participant determined to be speaking by the first participant equipment or computing device. Accordingly, Applicants' claims are not anticipated.

d) Traversal of rejection of dependent claims

Because Applicants have established that the Office Action fails to provide sufficient evidentiary support and factual finding for rejecting independent claims 1, 27, 41, 47, 70, and 91 as anticipated by Barile, dependent claims 2-26, 28-40, 42-46, 48-69, 71-90, and 92-95, which necessarily incorporate every element of their respective independent claims, are therefore also not shown to be anticipated by Barile, for at least the same reasons as noted above. Accordingly, Applicants do not need to, and elect not to, specifically address additional legal insufficiencies in the grounds for rejection of the dependent claims in Paragraphs 6-30, and 32-53 of the Office Action.

C. Office Action's 35 U.S.C. § 103(a) Rejection of Claims 5, 29, 53, 94, and 95 Fails to Establish a *Prima Facie* Case of Obviousness

The Office Action rejected claims 5, 29, 53, 94, and 95 on grounds of obviousness under 35 U.S.C. 103(a) (Office Action, Pg.14, Paragraphs 54-61). Because the cited grounds for rejection do not satisfy the legal requirement of providing a reasoned analysis based on factual findings that are supported by substantial evidence in the record, Applicants respectfully traverse the rejections as not establishing a *prima facie* case of obviousness.

1) Applicable Legal Standard for Establishing a *Prima Facie* Case of Obviousness

In *KSR Intn'l Co. v. Teleflex, Inc. (KSR)*, 550 U.S. ___, 82 USPQ2d 1385 (2007), the U.S. Supreme Court reiterated that the appropriate framework for conducting the objective analysis required to make a determination of obviousness under 35 U.S.C. § 103 is provided in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Obviousness is a question of law based on underlying factual inquiries. (MPEP 2141 II.) As specified in *Graham*, a proper obviousness analysis is based on factual inquiries, which, in part, require that: 1) the scope and content of the prior art are to be determined; 2) differences between the prior art

and the claims at issue are to be ascertained; and 3) the level of ordinary skill in the pertinent art is to be resolved. (*Id.* (citing *Graham*, at 17-18, 148 USPQ at 467)).

The MPEP's "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103" provide illustrative guidance on properly conducting the relevant legal analysis during examination of an application before the U.S. Patent and Trademark Office. (MPEP § 2141). To determine the scope and content of the prior art, one "must first obtain a thorough understanding of the invention disclosed and claimed in the application under examination by reading the specification, including the claims, to understand what the applicant has invented." (MPEP § 2141 II.A.) Ascertaining the differences between the claimed invention and the prior art requires interpreting the claim language...and considering both the invention and the prior art as a whole. (*Id.*). Finally, an "obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill." (*Id.*). An Office Action making an obviousness rejection must "ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied." (*Id.*). "Factual findings made by Office personnel are the necessary underpinnings to establish obviousness." (*Id.*).

Although a determination of obviousness must be based on sufficient factual findings provided in the record, merely providing factual findings, without more, is insufficient for establishing a rejection on obviousness grounds, even if the factual findings would be supported by substantively evidence. Statutorily, Applicants are required under 35 U.S.C. § 132 to be notified of the "reasons for such rejection" so that they can decide how best to respond. (35 U.S.C. § 132). The MPEP reiterates this requirement. (MPEP § 2141 II.A. "Once the findings of fact are articulated, Office personnel must provide an explanation to support an obviousness rejection under 35 U.S.C. 103.").

"The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." MPEP § 2142. As stated in the MPEP:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been

obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

(MPEP § 2142). In the recent *KSR* decision, the Supreme Court identified a number of rationales available to support a conclusion of obviousness, but it noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit. (MPEP 2143 (citing *KSR*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395-97 (2007))). It is under this framework that the legal sufficiency of the present rejections is reviewed. Properly establishing a *prima facie* case of obviousness under 35 U.S.C. § 103 requires both factual findings sufficiently supported by substantial evidence in the record and a reasoned analysis or explanation of the rationale as to why, given the factual findings on record, the claimed invention would be obvious to one of the requisite skill in the art.

2) Traversal of Claim Rejections as Not Establishing a *Prima Facie* Case of Obviousness under 35 USC § 103

The Office Action erred substantively by failing to make all of the requisite factual findings, making factual findings that are not supported by substantial evidence, and failing to provide a legally sufficient, clear articulation of the reasoning supporting the stated conclusion of obviousness. Accordingly, Applicants traverse the proffered grounds for the rejections as failing to establish a *prima facie* case of obviousness.

a) The Office Action Did Not Make all Requisite Factual Findings Explicit in the Record

Applicants respectfully assert that the Office Action did not establish a *prima facie* case of obviousness because it did not make all of the required factual findings on the record. As previously stated, part of a proper *prima facie* showing of obviousness is the resolution of

the *Graham* factual inquiries. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). This includes resolving the level of ordinary skill in the art. The Office Action, however, is completely silent as to the applicable level of skill in the relevant art. The Office Action places no explicit findings on the record for this requisite factual inquiry. Similarly, the Office Action fails to make findings as to why the cited references would specifically be within the knowledge of the applicable skilled artisan. Because the legal conclusion of obviousness is determined through the eyes of a person having ordinary skill in the art at the time of Applicants' invention, Applicants cannot meaningfully evaluate the appropriateness of the cited references or respond to the obviousness rejections in the Office Action without a clear factual finding being placed on the record to indicate what is being asserted as the applicable skill in the art. Without making the requisite findings in the record, the Office Action fails to establish a *prima facie* case of obviousness.

b) The Rejections Rely on Factual Findings Unsupported by Substantial Evidence

In addition to, and independent of, the reason discussed above, Applicants respectfully assert that the Office Action additionally fails to establish a *prima facie* case of obviousness because the factual findings offered to support the rejections are not supported by substantial evidence. For each claim rejected on obviousness grounds, the Office Action frames the rejection in the following format: "In regards to [the rejected claim], Barile discloses all of [the rejected claim's] limitations, except [a stated difference in subject matter]." (Office Action Pgs.14-16, Paragraphs 55, 57, 59, and 61). However, the factual finding that Barile discloses all of remaining limitations for each rejected claim is not supported by the evidence on record, and thus is erroneous and inadequate for establishing a *prima facie* case of obviousness.

The Office Action relies upon Barile as the primary reference supporting each obviousness rejection. However, the Office Action does not cite to any specific disclosure within Barile that provides evidence supporting the asserted factual finding that Barile discloses all limitations of the rejected claim except for the difference stated. Because the legal determination of obviousness must be based on factual findings supported by substantial evidence in the record, the Office Action does not establish a *prima facie* case of obviousness.

Assuming, for the sake of advancing examination, that the Office Action seeks evidentiary support for the obviousness rejections in the same sections of Barile's disclosure cited for the anticipation rejections discussed above, Applicants maintain that such evidence, even if properly placed on the record, still would be insufficient to support the stated factual finding and ultimate conclusion of obviousness proffered in the Office Action. Claim 5 depends from, and therefore includes every limitation of, independent claim 1. Claim 29 depends from, and therefore includes every limitation of, independent claim 27. Claim 53 depends from, and therefore includes every limitation of, independent claim 47 (via intermediate claims 50 and 51), and claims 94 & 95 each depend from, and therefore include every limitation of, independent claim 91. As Applicants' have established above, in traversing the rejections of independent claims 1, 27, 47, and 91 on the asserted grounds of anticipation by Barile, the Office Action simply does not offer sufficient evidence to support a finding that Barile discloses every limitation of the independent claims, as originally presented or as currently amended. Therefore, because the rejected dependent claims also include those same limitations, via dependency, it necessarily follows that the Office Action's finding that Barile discloses those limitations as part of the rejected dependent claims is equally not supported by the evidence on record.

**c) The Obviousness Rejections Fail to Provide a Legally
Sufficient, Clearly Articulated Rationale as to Why the Claimed
Invention Would be Obvious**

As an additional or alternative ground for traversal, Applicants respectfully assert that the Office Action's rejections of claims 5, 29, 53, 94 and 95 do not establish a *prima facie* case of obviousness because they do not provide legally sufficient, clearly articulated reasoning to support the stated conclusion of obviousness. Rather, the rejections impermissibly rely upon inadequately supported statements that are conclusory in nature.

In addition to the Office Action's failure to make finding as to the applicable skill level of an relevant artisan, or why the cited references would be within the knowledge of such person if the applicable skill level were established, the Office Action fails to provide sufficient reasoning to indicate why, at the time of Applicants' invention, a person with ordinary skill in the art would be motivated, or why it would otherwise be obvious to such a

person, to modify Barile, or combine the Barile with the other cited references, to achieve Applicants' claimed subject matter. Instead, the Office Action merely makes conclusory statements that the modification would be obviousness, based simply on assertions of the general functionality purported offered by the missing elements. Simply providing a statement as to the functionality of a missing element, or indicating that a missing element is disclosed in another reference, does not satisfy the Office Action's initial burden of providing clearly articulated reasoning as to why it would be obvious for someone of an appropriate skill level to modify Barile with the missing element. The reasoning serving as the basis for the conclusion of obviousness must be clearly articulated on the record.

To establish a *prima facie* case of obviousness, an Office Action must make the requisite factual findings, supported by substantial evidence. It must also offer a legally sufficient and clearly articulated rationale supporting the legal conclusion of obviousness based on those factual findings. Accordingly, if the Examiner desires to reassert the present obviousness rejections, Applicants respectfully request that they be provided with an additional non-final Office Action providing explicit factual findings to correct the omissions and errors indicated above. Such factual finding must be supported by substantial evidence in the record. Applicants also request that any new or reasserted obviousness rejections provide legally sufficient reasoning, explicitly and clearly articulated for the record, as to why, at the time of Applicants' invention, such person would have been motivated, or why it otherwise would have been obvious, to modify the primary reference or combine references in the manner asserted. Without providing such a showing, a *prima facie* case of obviousness cannot be established and the claim rejections should be withdrawn.

3. Other Claim Amendments

Applicants presently amend claims 26 and 40 for clarity purposes and to facilitate substantive examination.

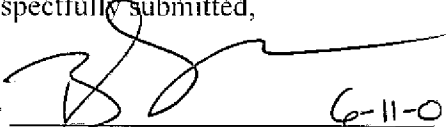
Conclusion

For the reasons discussed above, and in consideration of the present amendments, Applicants' respectfully assert that all pending claims are directed to statutory subject matter and present novel and non-obvious improvements over the applied prior art references of record. Because the application record includes no reference citation or factual findings adequate to support a legal conclusion of non-patentability for the pending claims, Applicants believe the application is in condition for allowance and respectfully request the same.

In the event that any of claims remain rejected in light of Applicants' present Amendment and response, or if the Examiner finds Applicants' arguments presented herein unpersuasive for any reason, Applicants respectfully requests that the Examiner provide another non-final Office Action affording Applicants an opportunity to address specific issues raised by the continued or new rejections. Applicants' welcome the Examiner to contact the undersigned attorney representative for a telephone conference to address any remaining questions or concerns the Examiner may have, or to discuss any matters that may facilitate resolution of the present application toward allowance.

Respectfully submitted,

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